

Application No. 10/021,602  
Amendment Dated 4/20/09  
Reply to Office Action of 10/20/08

**REMARKS**

This Amendment is submitted in response to the Office Action mailed on October 20, 2008. Claim 5 has been amended, and claims 5 and 44-57 remain pending in the present application. In view of the foregoing amendments, as well as the following remarks, Applicants respectfully submit that this application is in complete condition for allowance and requests reconsideration of the application in this regard.

Claims 5 and 44-57 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Fisch, RE 35,589 in view of Tolles, U.S. Patent No. 4,171,866. This rejection was maintained from the previous Office Action mailed January 8, 2008. In that Office Action, the same rejection was maintained from the Office Action mailed September 18, 2007. Applicants respectfully traverse the outstanding rejections for the reasons developed below and respectfully request that the rejections be withdrawn.

In the most recent Office Action, Examiner properly recognizes that Fisch fails to teach or suggest a pair of non-contiguous spacer segments attached to a bottom surface of a cover slip as recited in independent claim 5. Rather, as Examiner properly recognized in the Office Action mailed September 18, 2007, Fisch discloses a thin spacer layer (23) sandwiched between a cover slip (3) and a slide (2). The space formed by the spacer layer (23) creates a circular sample chamber in which the sample will remain during examining (see Page 3, Paragraph 3 of Office Action dated 9/18/07).

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Examiner will note that in each embodiment of the Fisch slide assembly that includes a spacer layer (23 or 73), the slide assembly further includes a circular sample chamber (24 or 74), an overflow chamber (25 or 75) and a separating wall (26 or 76) (see Figs. 1a, 1b and 4).

In an attempt to cure the deficiency in Fisch, Examiner asserts that one of ordinary skill in the art would be motivated to modify the film layer of Fisch to comprise a pair of spacer segments as taught by Tolles to allegedly arrive at Applicants' claimed invention as recited in independent claim 5. However, this is simply not the case as set forth below.

In particular, Examiner will note that in the slide assembly of Tolles, the tape sections (19) do not extend along a longitudinal dimension of the cover slips (20), but rather extend along the cross-width dimension of the cover slips (20) as shown in Fig. 3. Moreover, as Examiner properly recognized in the Office Action mailed January 8, 2008, the spacer segments of Tolles do not extend to the edges of the cover slip so as to extend substantially contiguously with a full length of the opposed longitudinal edges of the cover slip as recited in independent claim 5.

In view of the above, it would appear that a hypothetical combination of Fisch and Tolles would result, at best, in a slide assembly having a pair of spacer segments extending in a cross-width dimension, with the pair of spacer segments being located inwardly from opposite side edges of the cover slip. The hypothetical combination would also include a circular sample chamber, an overflow chamber and a

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separating wall sandwiched between the glass slide and the cover slip as these features appear in each embodiment of the Fisch slide assembly that includes a spacer layer.

Applicants respectfully submit that this hypothetical combination would fail to achieve Applicants' claimed invention as recited in independent claim 5 since it would fail to include the combination of elements as claimed, including a pair of noncontiguous spacer segments attached to a bottom surface of the cover slip, with each spacer segment extending substantially contiguously with a full length of a different one of the opposed longitudinal edges.

Applicants have amended claim 5 to clarify that the opposite longitudinal edges extend the longitudinal length of the cover slip.

Moreover, Examiner will note that independent claim 5 recites the pair of spacer segments forms a hybridization chamber between the spacer segments, the bottom surface of the cover slip and the top surface of the substrate (see lines 13-15), with the hybridization chamber being adapted to contain the hybridization material when the cover slip is placed on the substrate with the spacer segments sandwiched therebetween (see lines 19-21).

In the hypothetical combination of Fisch and Tolles as set forth above, by contrast, the pair of spacer segments would not form a hybridization chamber between the spacer segments as recited in independent claim 5 since the hypothetical combination would include the circular sample chamber and the separating wall that

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would contain the hybridization material independent of the pair of spacer segments. In other words, the pair of spacer segments in the hypothetical combination would not form any part of the hybridization chamber since that chamber would rather be defined by the separating wall surrounding the sample chamber.

For each of these reasons, Applicants respectfully submit that the hypothetical combination of Fisch and Tolles fails to achieve Applicants claimed invention as recited in independent claim 5 and the rejection should be withdrawn.

Moreover, as each of claims 5 and 44-57 recites a cover slip having a thickness of at least 0.85 mm and a hybridization chamber comprising an area between the spacer segments of at least 500 square mm, which features are not fairly taught or suggested by the prior art of record for the reasons set forth in Applicants' prior responses which are incorporated herein by reference in their entireties, Applicants submit that the rejections of these claims are improper for these reasons as well.

For example, Fisch discloses a slide cover having a thickness of 0.1 to 0.5 mm (see Col. 3, lines 60-64). Tolles discloses a cover slip having a thickness of 0.18 mm (see Col. 3, lines 36-39).

As independent claim 5 recites that the cover slip thickness of at least 0.85 mm is sufficient to provide a cover slip beam stiffness that prevents adhesion forces from substantially changing the substantially constant distance between the bottom surface of the cover slip and the top surface of the substrate, which feature would apparently not be achieved by the cover slips of Fisch and Tolles, Applicants

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submit that the claimed cover slip thickness would indeed perform differently than the prior art devices of record so as to be patentably distinct therefrom.

As claims 44-57 depend from allowable independent claim 5, and further as each of these claims recites a combination of elements not fairly taught or suggested by the prior art of record, Applicants submit that these claims are allowable as well.

Applicants have filed on even date herewith a Fourth Supplemental Information Disclosure Statement to cite an Office Action received in Applicants' corresponding European Patent Application No. 02 794 211.9-2217. Each of the references cited in that Office Action is already of record in the present application.

Applicants have also filed herewith a Request for Continued Examination so that Applicants' After Final Amendment and Fourth Supplemental Information Disclosure Statement will be entered and considered by Examiner.

### CONCLUSION

In view of the foregoing response including the amendments and remarks, this application is submitted to be in complete condition for allowance and early notice to this affect is earnestly solicited. If there is any issue that remains which may be resolved by telephone conference, Examiner is invited to contact the undersigned in order to resolve the same and expedite the allowance of this application.

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Please see the electronic fee calculation sheet for the charge in the amount of \$810 for the RCE fee as required by 37 C.F.R. §1.17(e), for the charge in the amount of \$1,110 for the three months extension fee as required by 37 C.F.R. §1.17(a)(3) and for the charge in the amount of \$180 for the Information Disclosure Statement fee as required by 37 C.F.R. §1.17(p). If any other fees are necessary, the Commissioner is hereby authorized to charge any underpayment or fees associated with this communication or credit any overpayment to Deposit Account No. 23-3000.

Respectfully submitted,

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